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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,875	01/12/2001	Jerome L. Krupa	P1329USA	2537

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GARDNER, CARTON & DOUGLAS
PATENT DOCKET DEPT.
321 N. CLARK STREET - SUITE 3400
CHICAGO, IL 60610

EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 11/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,875

Applicant(s)

KRUPA, JEROME L.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1 has been amended. The drawings and specification have been amended to overcome the previous drawing objections.

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Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “outer edge” as claimed in Claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 1, discloses an “outer edge” which is not disclosed in the specification. Should “outer edge” be disclosed as an “ edge”?

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitations: "outer edge" in line 3; and "a side of the outer edge" in line 4. Why is the edge an "outer edge" and where is the inner edge? There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-5, 7-9, 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Petrick et al (6,343,695) in view of De La Huerga (PAP 2001/001178817).

Petrick et al discloses in Fig. 1 and 2A, a label for use on a bottle container having a symbol (barcode indicia (45) on symbol label (36)), wherein the label (33) comprising indicia (42); wherein the symbol (45) and label indicia (42) are electronically read.

However, Petrick et al does not disclose: a label having a first portion having an edge; and a second portion extending out and away from a side edge; wherein the label and symbol are compared to determine if contents correspond to the label; a second portion extending from the corner of the first portion; second portion is rectangular; wherein the indicia is a checksum of the symbol.

De La Huerga discloses in Fig. 16 and 17 a label (50) having a rectangular first portion (527) with an edge and a second portion (529) having a bar code indicia (Col. 9, Par. 0111) and extending out and away from the edge.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petrick et al's label and replace it with a label having a first portion and a second portion as taught by De La Huerga for the purpose of providing the electronically readable indicia to be easily recognizable and distinct from the main label portion.

In regards to **Claims 1, 12 and 13**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure

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is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the symbol and label indica can be programed to be used to determine any result desired by the end user.

In regards to **Claim 3**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to extend the second portion at any desirable location from the first portion, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 4**, it would have been an obvious matter of design choice to make the second portion of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

In regards to **Claims 7-8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desired substance in the container, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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6. Claim 6, 10 and 14, are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Petrick et al in view of De La Huerga and further in view of Seidl.

Petrack et al as modified by De La Huerga discloses a label comprising all the elements as claimed in Claim 1, and as set forth above. However, Petrick et al and De La Huerga do not disclose wherein a bar code reader reads the symbol and indicia simultaneously; and wherein the symbol and the indicia are aligned and in which the second portion covers a portion of the symbol.

Seidl discloses in Fig. 2A and 4, an aligned symbol (2) and a label (1) in which the symbol and indicia can partially overlap one another and can be read simultaneously by a bar code reader.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petrick et al's and De La Huerga's label to include a symbol and a label indicia which can be read simultaneously as taught by Seidl for the purpose of linking various forms of information.

Response to Arguments

7. Applicant's arguments filed on September 3, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument that prior art does not teach that the indicia and symbol are read and compare to determine if the contents of the container corresponds to the

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label, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the symbol and label indicia can be programmed to be used to determine any result desired by the end user.

In response to the applicant's arguments that the prior art does not teach "a second portion extending out and away from a side of the outer edge", the examiner submits it would have been obvious to one having ordinary skill in the art at the time the invention was made to extend the second portion at any desirable location from the first portion, since it has been held that rearranging parts of an invention involves only routine skill in the art. Furthermore, applicant has disclosed an "outer edge" which is not disclosed in the specification. The specification on page 12, lines 3-10 describes the edges of the label portion as a "side edge". Should "outer edge" be disclosed as a "side edge" and if it is an "outer edge", where is the "inner edge"?

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Conclusion

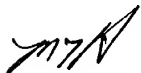
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

November 23, 2002



A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700